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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/653,224      | 08/31/2000  | Robert C. Mayes      | 10006908-1          | 4787             |

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HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER

NGUYEN, TAN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3629

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/653,224

Applicant(s)

MAYES, ROBERT C.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

The amendment filed 4/16/04 has been entered.

***Claim Status***

Claims 1, 4-15 are active and are treated as followed.

***Response to Arguments***

1. Applicant's arguments (about 4), see paper no. 6, filed 10/17/03, with respect to the rejection(s) of claim(s) 1, 4-6, 7-11, 12-15 under GARRIDO in view of BURTON has been fully considered and are not persuasive for the reasons set forth below.

1) Applicant's comment that there is no teaching of the restriction of font size of paper size the user can select is not persuasive in view of paragraph 6 below.

2) Applicant's comment that there is no teaching in claim 1 with respect to the selection of format criteria and page and cover according to the received dimension is not persuasive in view of paragraph 6 below.

3) Applicant's comment that Burton teaches receiving a measurement of a customer (not a book storage space) and tailoring a garment according to that measurement is noted but these are found persuasive because BURTON is merely cited to teach the custom made steps for any types of item with garment being one of the type and the use of other type material such as book would have been obvious as mentioned in paragraph 6 below.

4) Applicant's comment with respect to Articles 3/1998 and 10/1987 are noted and not persuasive because these articles are merely cited to teach well known issue in

producing book is making sure it's fitting well or perfectly into a book storage space or bookshelf or pocket or any convenient holder. These articles have been removed from rejections above.

***Claim Rejections - 35 USC § 112***

2. Claims 1, 4-6, 7-11 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 7, 12, It's not clear the phrase "selecting format criteria and page and cover media" is with respect to what? Changing the phrase to "selecting the book format criteria and book page and book cover media" is recommended to improve clarity.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-6, 7-11, 12-15 are rejected under 35 U.S.C. 103(a) as obvious over GARRIDO (US Patent 6,012,890) in view of BURTON et al (US Patent 4,598,376).

As for independent method claim 1, GARRIDO discloses a book manufacturing method and computer readable media having instructions for:

- (a) identifying a set of items (books),
- (c ) selecting the item format criteria and page and cover media, and

(d) manufacturing the set of books (see col. 7, lines 20-65 or (c7: 20-65), c9: 5-20).

GARRIDO teaches the claimed invention except for:

steps (b) receiving a dimension information of an item (book) storage space (or book holder), and

carrying out steps (c ) and (d) according the dimension information of (b).

5. In a general method and apparatus to overcome traditional manufacturing inefficiency by the "off-the-rack" or "off-the-shelf" or "off-inventory" method for producing for items, BURTON replacing this traditional method with a custom made (or tailored or manufactured made) method to produce items that will fit the item holder, BURTON discloses an item manufacturing method to encompass this scope comprising:

(a) identifying a set of items (garments, vests, suits),

(b) receiving an information with respect to the dimension (or measurement) of the item holder (customer's body),

(c ) selecting the item format criteria according to (b), the selection being made so that the set of items, once manufactured, will fit within the item holder , and

(d) manufacturing the set of items (vests, suits) according to the selected format criteria. (see c1:8, c1:48-55, c2:1-3, c5:25-40) for the benefits of: increase efficiency by reducing 1) waste in materials 2) cost, 3) high overhead in inventory, 4) time waiting, due to "off-the-rack" or "off-the-shelf" or "off-inventory" method (see col. 1).

6. It would have been obvious to modify the teaching of GARRIDO by including the teachings of steps (b) and modified steps (c) and (d) as taught by BURTON (according

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to item holder) according to the received dimension (or measurement) of the item holder to properly fit the item holder for at least one of the benefits as taught by BURTON above. It would have been obvious for an artisan to select a format criteria defining font size and paper and cover media so that the book can be properly printed and sized to fit the item holder in the future after manufacturing. For, example, selecting a font size too high or big will increase the book thickness or height which may not fit the book holder. Selecting a cover so large would not fit into the holder properly. As for the difference between "set of books" and "set of garments, vests, or suites", these are merely the difference in the type of personal items and are taught by BURTON on col. 11, lines 10-15 or would have been obvious to a skilled artisan in the manufacturing art as mere applying the same treating steps to other similar/equivalent items to obtain similar results, absent evidence of unexpected results (selection of equivalent/similar for art recognized similarity). As for any difference between item holder or item storage space, this is merely difference in the term or language use to describe a general item holding and is within the knowledge of the artisan or would have been obvious as various way of describing an item holding/storing area. Note that the key issue is measuring the item in advance according to the dimension information of the item holder prior to manufacturing to fit the desired item holding once manufactured and reducing waste or not fitting. The application of this concept to any item and item holder/storing space would have been obvious.

**As for dep. claims 4-6** (part of 1 above), the steps for receiving payment information before or after manufacturing are well known/conventional to pay for the

books and would have been obvious to a skilled artisan or inherently included in the teaching of GARRIDO or BURTON et al.

7. **As for independent apparatus claim 7**, this is fairly taught in book on-demand system of GARRIDO as shown in Fig. 1, 2A, 2B, 3 and c2:60-65, c3:1-20, c4:40-50, c5:60-67, c6:30-67, c7:1-60 and in view of the teachings of BURTON as shown in claim 1 above. Alternatively, the setting up of equivalent system to carry out the equivalent method claim (claim 1) is within the skill of the artisan and would have been obvious to a skilled artisan.

**As for dep. claims 8-9** (part of 7 above), these have the same limitations as in claims 4-6 above and are rejected for the same reasons set forth above.

**As for dep. claims 10-11** (part of 7 above), these are fairly taught in GARRIDO c2, line 65 to col. 3, line 30, c5:40-67, c6:40 to c7, line 20.

8. **As for Independent product claim 12**, this is rejected over the computer readable media in the computer system of GARRIDO and in view of the teachings of BURTON (computer system and measuring devices as in c11: 5-16) as shown in Independent method claim 1 above. Alternatively, the setting up of equivalent computer readable media to carry out the equivalent method claim (claim 1) is within the skill of the artisan and would have been obvious to a skilled artisan.

**As for dep. claims 13-15** (part of 12 above), these have the same limitations as in claims 4-6 above and are rejected for the same reasons set forth above.

In summary, the general teaching of BURTON to overcome traditional manufacturing inefficiency by the "off-the-rack" or "off-the-shelf" or "off-inventory"

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method for producing for items, BURTON replacing this traditional method with a custom made (or tailored or manufactured made) method to produce items that will fit the item holder. The selection of any other personal item and item holder such as book and book holder (or book storage space) is within the skill of the artisan and would have been obvious. The combination of this teaching into GARRIDO, a book on-demand system, would yield the claimed invention and overcome all of the problems mentioned in the specification.



**Conclusion**

9. Applicant's amendment necessitated the new ground(s) of rejection (only 112, 2<sup>nd</sup>) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

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11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or [http:pair-direct@uspto.gov](mailto:http:pair-direct@uspto.gov).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov) .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

|                                 |                      |
|---------------------------------|----------------------|
| Allowed Files & Publication     | (703) 305-8322       |
| Assignment Branch               | (703) 308-9287       |
| Certificates of Correction      | (703) 305-8309       |
| Drawing Corrections/Draftsman   | (703) 305-8404/ 8335 |
| Fee Questions                   | (703) 305-5125       |
| Intellectual Property Questions | (703) 305-8217       |
| Petitions/Special Programs      | (703) 305-9282       |
| Terminal Disclaimers            | (703) 305-8408       |
| Information Help Line           | 1-800-786-9199       |

dtn  
July 2, 2004

  
**DEAN T. NGUYEN**  
**PRIMARY EXAMINER**